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EXAMINER  
HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
1731	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 40115

Application Number: 09/745,414  
Filing Date: April 05, 2001  
Appellant(s): PEDRIDO ET AL.

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Raja Saliba  
For Appellant

**MAILED**

**JAN 29 2004**

**GROUP 1700**

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12 November 2003.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals [none] and interferences [none] which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claim 10. The rejection of claims 11-15 is herein withdrawn, because the disclosure shows that the Applicant had possession of the invention at the time of filing.

Claims 1-9 and 11-15 are allowed.

**(4) Status of Amendments After Final**

The amendment after final rejection filed on 3 July 2003 has not been entered.

**(5) Summary of Invention**

The summary of invention contained in the brief is deficient because it fails to mention the claimed "inlet", "outlet", "first conveying path", "first seal", and the requirement that the injector is between the closure member and the outlet. Looking at

Appellant's figure 2: the "inlet" would be the top hole surface of (18A); the "outlet" the bottom hole surface of 6; the "first conveying path" is not structure, but is readily evident from figures 2-4; the first seal is 7A; the location of the injector is clearly seen from the drawings.

The summary is also deficient because it fails to refer to the specification by page AND line number. It only states by page number. However, the invention is clear from the drawings. The only point of contention regarding claim interpretation being the preamble usage of "for inserting a preform".

Whereas the Summary includes discussion of the furnace: such only pertains to claim 11 which is now allowed. Claim 10 does not require a furnace to be part of the apparatus.

**(6) Issues**

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Issue 1 is the only remaining issue.

**(7) Grouping of Claims**

Not applicable. Only one claim is rejected.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,713,979

NICHOLSON et al

2-1998

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Nicholson 5713979.

See Nicholson's figure 1: the structure which reads on the claimed invention includes Furnaces A and B. It does not include Chamber C, nor features 7 and 9. The fact that Nicholson shows other structure used in conjunction with Furnaces A and B is largely irrelevant. "The mere fact that a given structure is integral does not preclude its consisting of various elements" *Nerwin v. Erlichman*, 168 USPQ 177, 179 (PTO Bd. Of Int, 1969). Furthermore, Appellant's drawings show the inlet arrangement which is connected to non-claimed structure (4). Also, there is no figure which shows the inlet arrangement which is separate from all other features. Therefore, reading the claim in light of the specification: the claim reads on inlet arrangements which are connected to structure which is not provided for in the claims.

Art Unit: 1731

Preamble: The claimed arrangement is for inserting a preform into a furnace for drawing a fiber. The body of the claim makes no indication that the furnace is part of the claimed invention. There is nothing which precludes arrangement from being used with another furnace (such as Nicholson's sintering furnace). {This IS disputed by Appellant}

"an inlet" - the top of Nicholson's 8 is an inlet. {This is not disputed by Appellant}

"an outlet downstream of the inlet" - The hole of the bottom of flange 21 is the outlet. {This is not disputed by Appellant}

" a first conveying path..." it is the direct path from the inlet to the outlet.

Whereas Nicholson's preform 9 cannot be conveyed "through the inlet", once can convey a preform with a diameter equal to the diameter of Nicholson's shaft 7. The claims do not limit the size of the "inlet" so as to not read on preforms of narrow diameter. {This is not disputed by Appellant}

"a first seal" - feature 8 has this seal (col 8, line 10). {This is not disputed by Appellant}

"a closure member..." - 11 and/or 10 comprise the closure member. See col 8, lines 18-22 which disclose the opening and closing. {This is not disputed by Appellant}

"an injector..." Whereas Nicholson's figure 1 has an injector (25) which is "downstream of the closure member". But it is not "between the closure member and the outlet" as required by the claim. However the text does provide for an injector "between the closure member and the outlet. Col. 8, line 66-67 teaches means to introduce gas into "furnace B, and/or to chamber C". This is a teaching to have means

Art Unit: 1731

which introduce gas into: B and C; B without C; as well as C without B. In other words, the "or" of "and/or" is an exclusive "or". For if it was to be an inclusive "or", there would have been no reason to have the 'and' of "and/or". {This IS disputed by Appellant}

Alternatively, if there is any doubt as to whether it is an exclusive "or", then one would have to interpret it as covering both an exclusive "or" and an inclusive "or". So therefore, it teaches feeding gas to B without feeding it to C. One would immediately envisage having a feed pipe which feeds directly into B. Note, col. 9, line 4 indicates that it would be clear to one of ordinary skill that different arrangements would be possible. To examiner, this is evidence that one of ordinary skill that would at once envisage "alternative pipework arrangements".

To feed a gas into a chamber, it can only come from the top, the bottom or a side. A pipe can't come in from Nicholson's top or the bottom, therefore it must come in from the side: if the pipe came in the top or the bottom, it would make the apparatus inoperable for its intended use. And any side location would be "between the closure member and the outlet" as required by the claim.

### **(11) Response to Arguments**

The first argument is at the last three lines of page 6: that Nicholson does not teach or suggest the arrangement comprising: the first seal, the closure member, and injector below the first seal and the closure member. It does not state what in particular is missing. The rejection addresses all of the claim limitations - there is no indication what the error is. The argument is merely a conclusion with no evidence to support it.

The second argument starts at line 11 of page 7, and includes: (a) that Nicholson's pipe is downstream of the claimed location; (b) that there is no teaching or suggestion to have the injector in the claimed location; (c) that the "clearly possible" language does not give guidance how/where to include the alternative arrangement; (d) that the "clearly possible" language is merely an invitation to experiment; (e) that one of ordinary skill would be motivated to maintain the arrangement shown in Nicholson.

As to (a) (that Nicholson's pipe is down stream of the claimed location). This is one embodiment of Nicholson which schematically represents the possible arrangements (col. 9, line 2). The rejection is not based on the concrete/specific embodiment of Nicholson's figure 1. This argument does not pertain to the rejection based on the "alternative" embodiments.

As to (b) (that there is no teaching or suggestion to have the injector in the claimed location). One of ordinary skill would at once envisage the claimed location. If the pipe were to come in from the top or the bottom of B, it would make the Nicholson inoperable - the only alternative is to have it feed in from the side. It would be inoperable because the preform could not pass through with the pipe in the passage. The clearest mode of introducing "inert and/or process gas into furnace B" is to have something that feeds directly into furnace B. The clearest way would be the equivalent structure of 25: a pipe that feeds directly to B.

As to (c) (that the "clearly possible" language does not give guidance how/where to include the alternative arrangement.) This is true. However, Nicholson states that

Art Unit: 1731

the alternatives are "clear" to one of ordinary skill. It is well-understood practice that specifications need not spell out every detail of an invention.

The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563, 19 USPQ2d at 1116.

Examiner cannot fathom that one of ordinary skill would not know how to feed a gas to a chamber.

As to (d) (that the "clearly possible" language is merely an invitation to experiment). As indicated above, the "clearly possible" statement is evidence as to the ability/nature of one of ordinary skill: that one of ordinary skill having the Nicholson reference would at once envisage alternative ways of arranging the pipes.

As to (e), (that one of ordinary skill would be motivated to maintain the arrangement shown in Nicholson.) A teaching away is relevant only as a matter of unobviousness - it is not relevant in making a determination of novelty. Examiner could find no motivation to have an inlet on section B - thus no rejection under 35 USC 103 was made - only an rejection under 35 USC 102(b).

The last argument begins on the third line of page 8: that none of the Nicholson's embodiments disclose furnaces that have openings from which a fiber could

Art Unit: 1731

be drawn. And therefore Nicholson's invention is not for "drawing a fiber". This is irrelevant, because claim 10 does not require any structure for drawing a fiber. Rather, the preamble states that the apparatus is "for inserting a preform into a furnace". Claim 10 does not require that the furnace be part of the inlet arrangement - compare to instant claim 11 which does require a furnace. Applicant's figure 3 shows that the fiber is not drawn from the inlet arrangement, rather it is drawn from structure which is below the claimed inlet arrangement. Examiner has not interpreted claim 10 as requiring a draw-furnace, because such is not explicitly mentioned, and because for Examiner to do so, might give sanction a potential infringer to use the claimed arrangement in a sintering or other non-draw furnace.

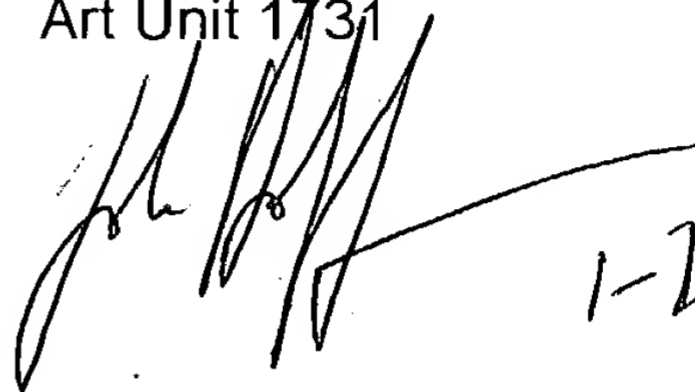
There is no indication why Nicholson's A and B (i.e. sans C) could not be used in conjunction with a fiber drawing furnace. A preamble which calls for "tongs for inserting a preform into a furnace for drawing a fiber" would generally not be limit the claim to tongs which are physically connected to a fiber. Rather, the tongs must simply be capable of doing the intended step.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1731

Respectfully submitted,

John Hoffmann  
Primary Examiner  
Art Unit 1731



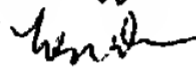
1-22-04

jmh

January 22, 2004

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